

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASUSTEK COMPUTER INC.,
Petitioner,

v.

VIDEOLABS, INC.,
Patent Owner.

IPR2025-00304
IPR2025-00306
Patent 8,291,236 B2

Before KARL D. EASTHOM, STACEY G. WHITE, and BRIAN P.
MURPHY, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

ORDER¹

Granting Petitioner's Motion to Dismiss the Petition
Denying Petitioner's Motion for Joinder
35 U.S.C. § 315 (b, c); 37 C.F.R. §§ 42.71(a), 42.122

¹ This Order applies to both cases. The parties must seek prior authorization to employ this heading style.

I. INTRODUCTION

In IPR2025-00304, Petitioner ASUSTek Computer Inc. (“Petitioner”) filed a Petition pursuant to 35 U.S.C. § 311 requesting institution of *inter partes* review of claims 32–36, 38–41, 43, 66–70, 72–75, 77, and 130–137 of U.S. Patent No. 8,291,236 B2 (Ex. 1001, “’236 patent”). Paper 1 (“Pet.”). In IPR2025-00306, Petitioner filed a Petition challenging different claims of the ’236 patent. *See* IPR2025-00306, Paper 1 (challenging claims 100–109 and 111 of the ’236 patent).

The Petition identifies *Roku Inc. v. VideoLabs, Inc.*, IPR2024-01023 (“’1023 Roku IPR”) and IPR2024-01025 (“’1025 Roku IPR”) as related proceedings challenging the same claims of the ’236 patent that Petitioner challenges here in IPR2025-00304 and IPR2025-00306, respectively. Pet. 6.² In each case, Petitioner filed a Motion for Joinder with its Petition requesting joinder as a “copycat” petition to each instituted Roku IPR. *Id.*; Paper 4 (“Joinder Motion”); *see also* ’1023 Roku IPR, Paper 12 (instituting ’1023 Roku IPR); ’1025 Roku IPR, Paper 12 (instituting ’1025 Roku IPR).

On December 23, 2024, pursuant to our authorization, the parties in each Roku IPR filed a joint motion to terminate the proceeding due to settlement of all disputes between the parties related to the ’236 patent. ’1023 Roku IPR, Paper 14; ’1025 Roku IPR, Paper 14.

On January 3, 2025, Patent Owner VideoLabs, Inc. (“Patent Owner”) filed Mandatory Notices in the instant proceedings identifying the Roku IPRs as related proceedings, and Patent Owner further indicated that the parties in the Roku IPRs had filed a joint motion to terminate the Roku IPRs due to

² With respect to the instant proceedings, citations hereinafter refer to IPR2025-00304.

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settlement. Paper 7, 2. On January 16, 2025, Patent Owner filed an Opposition to Petitioner's Joinder Motion in view of the settlement and joint motion to terminate the Roku IPR. Paper 8 ("Opposition").

On January 21, 2025, in view of the settlement, we entered an Order terminating the Roku IPRs in each case ("Roku Termination Order(s)"). '1023 Roku IPR, Paper 16; '1025 Roku IPR, Paper 16.

On February 27, 2025, pursuant to our authorization, Petitioner filed a Motion to Withdraw the Petition "through dismissal" in each instant case. Paper 9 ("Motion to Dismiss"). Patent Owner, though authorized to file a response not later than March 6, 2025, has not responded to Petitioner's Motions to Dismiss. A preliminary response to the Petition is due to be filed no later than March 31, 2025 in each case. We address Petitioner's Joinder Motions and Motions to Dismiss below.

II. DISCUSSION

The Board has broad discretion to dismiss a petition. 37 C.F.R. § 42.71(a) ("The Board may take up petitions or motions for decisions in any order, may grant, deny, or dismiss any petition or motion, and may enter any appropriate order."); *see also id.* § 42.5(a) ("The Board may determine a proper course of conduct in a proceeding for any situation not specifically covered by this part[.]"). Joinder of a party to an *instituted inter partes* review is also within the Director's sound discretion, which has been delegated to the Board. 35 U.S.C. § 315(c) ("[T]he Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition."); *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321 (2020) ("[T]o effect joinder, § 315(c) requires the Director to exercise his discretion to decide whether to 'join as a party' the joinder applicant. That is,

the statute requires the Director (or the Board on behalf of the Director) to make a ‘joinder decision.’”). As we stated in the Roku Termination Order, “[w]e recognize that, if we terminate this proceeding, the motions for joinder may be moot and the petitions may be barred under 35 U.S.C. § 315(b).” ’1052 Roku IPR, Paper 16, 2; ’1053 Roku IPR, Paper 16, 2.

The parties agree that, absent joinder, § 315(b) bars the instant Petitions. Joinder Motion, 3–4 (“[T]he current Petition is not subject to the one-year statutory time bar *because it is accompanied by a request for joinder.*” (emphasis added)); Opposition, 8 (“There can be no dispute that, absent joinder, ASUSTeK’s Petition would be statutorily time barred.”). Thus, Petitioner relies on joinder to avoid the time bar of 35 U.S.C. § 315(b). Petitioner also acknowledges that, given the Roku Termination Orders, Petitioner’s Joinder Motions and Petitions are moot and dismissal of the Petitions is appropriate. Motion to Dismiss, 2. We agree. The Roku Termination Orders removed the statutory basis that underpins Petitioner’s Joinder Motions, rendering them moot, because in each case, there is no longer an instituted Roku IPR for Petitioner to join.

Accordingly, we dismiss the Petitions and deny the Joinder Motions in each case.

III. ORDER

ORDERED that Petitioner’s Joinder Motion in IPR2025-00304 and IPR2025-00306 is DENIED as moot; and,

FURTHER ORDERED that Petitioner’s unopposed Motion to Dismiss the Petition in IPR2025-00304 and IPR2025-00306 is GRANTED

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